

REMARKS

This paper is filed in response to the official action dated October 5, 2004 (hereafter, the official action). This paper is timely-filed, as it is accompanied by a petition for an extension of time to file in the third month and a check covering the requisite fee of \$1020.

Claims 1-36 are pending in this application. By the foregoing amendments, claims 1, 4, 5, 11, 12, 13, 16, 17 and 23 have been amended, claim 3 has been canceled, and new claims 37-39 have been added. A check covering the filing fee of \$100 for two additional total claims in excess of 20 is also submitted herewith. Support for the amendment to claim 1 may be found, for example, in original claim 3. Support for the amendment to claim 23 may be found, for example, at page 10, line 15 through page 11, line 16. Support for new claim 37 may be found, for example, at page 10, lines 9-13. Support for new claim 38 may be found, for example, at page 9, lines 16-21. Support for new claim 39 may be found, for example, in original claims 1, 9, and 22. No new matter has been added.

Claims 9 and 22 have been objected to, but are allowable in substance. Thus, claims 1, 2, 4-8, 10-21, and 23-39 remain at issue.

Claims 1-8, 10-21, and 23-36 have been rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 6,514,328 to Katoh *et al.* ("Katoh *et al.*").

The sole basis for rejecting the claims is addressed below. Reconsideration of the application, in view of the accompanying amendments and following remarks, is solicited.

CLAIM REJECTIONS -- 35 U.S.C. §103(a)

Claims 1-8, 10-21, and 23-36 have been rejected under 35 U.S.C. §103(a) as being obvious over Katoh *et al.* The applicants respectfully traverse the rejections.

A *prima facie* case of obviousness requires satisfaction of three legal criteria. First, there must be some suggestion or motivation, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Second, there must be a reasonable expectation of success in doing so. Third, prior art references, when combined, must teach or suggest all of the claim limitations. (See M.P.E.P. §2142).

Here, each of these three criteria cannot be demonstrated with respect to the claims, as amended herein, and therefore the rejections should be withdrawn.

A. Claims 1, 2, 4-8, and 10-21

Katoh *et al.* discloses an “ink composition [which] contains a dye, a pigment, a dispersion medium X in which the dye is practically soluble, and a dispersion medium Y in which the dye is practically insoluble, the dispersion media X and Y being mutually immiscible.” See Katoh *et al.* abstract. Katoh *et al.* further discloses that “it is effective to add a second dye which is preferentially dissolved in the dispersion medium Y in which the solubility of the above-mentioned first dye is smaller than that in the dispersion medium X.” See Katoh *et al.* column 10, lines 62-67.

Katoh *et al.* does not disclose or suggest a multi-color writing ink *consisting essentially* of a mixture of a first ink composition *consisting essentially of* a first solvent, a first dye, and an optional ink additive, and a second ink composition *consisting essentially of* a second solvent, a second dye, and an optional ink additive, wherein the first and second ink compositions are immiscible with each other, as recited by claims 1, 2, 4-8, and 10-21.

Rather, Katoh *et al.* always includes a *pigment powder* formed from materials such as titanium oxide, polyethylene, and carbon black because such particles are capable of migrating in response to an applied electric and/or magnetic field; such pigment particle migration from one dispersion medium into the second dispersion medium (and vice versa) is exploited by Katoh *et al.* “to provide a marking ink composition capable of reversibly displaying at least two color with excellent contrast or high degree of whiteness.” See Katoh *et al.* at column 2, lines 62-64.

Because Katoh *et al.* necessarily includes the aforementioned pigment powder, the rejections of claims 1-8 and 10-21 should be withdrawn.

B. Claims 23-36

Katoh *et al.* summarily discloses that the marking ink composition can be used in “a marking pen and sign pen.” See Katoh *et al.* at column 21, lines 31-34. However, the applicants respectfully submit that this disclosure, when read in view of the entire disclosure of Katoh *et al.* does not disclose or suggest the multi-color marker recited in claims 23-36.

Katoh *et al.* discloses an ink composition as previously discussed, and specifically discloses display media for the use thereof including a magnetic migration device (*see* Figure 1), an electrophoretic migration device (*see* Figure 5), an ink jet modulated by a piezoelectric device (*see* Figure 9), and generally discloses other similar structures including a liquid crystal and an electrochromic device (*see* column 1, lines 16-20). Each device capitalizes upon the migration of the ink composition pigment particles in response to an applied electric and/or magnetic field. Notably, Katoh *et al.* does not disclose or suggest the benefits of using an ink composition including pigment particles which in response to an applied electric and/or magnetic field. Thus, one of ordinary skill in the art would hardly be motivated to use an ink composition which relies upon the use of pigment particles that migrate in response to an electric and/or magnetic field in a writing instrument, much less the specific marker configuration comprising a fibrous ink reservoir and a fibrous nib recited in claims 23-36.

Furthermore, the presence of such pigment particles can be problematic for delivery of the multi-color inks from the markers recited in claims 23-36. For example, such pigments tend to clog the fibrous nibs of markers, and therefore can render the markers inoperable. Additionally, the pigments tend to settle out of solution and therefore are not always consistently delivered. Moreover, such pigments are typically not very selective with respect to the first and second solvents, and therefore tend to obscure the relative contrast of the individual ink compositions of the multi-color inks (*e.g.*, after delivery to a substrate). Finally, the addition of such pigments can cause the two immiscible ink compositions to form a single solution, thereby destroying the ability of the marker to deliver more than one color from the marker fibrous nib.

Because Katoh *et al.* fails to disclose or suggest a fibrous ink reservoir containing at least a mixture of a first ink composition comprising a first solvent and a first colorant and a second ink composition comprising a second solvent and a second colorant and a fibrous nib in fluid communication with the fibrous ink reservoir, wherein the first and second ink compositions are immiscible with each other, the rejection of claims 23-36 should be withdrawn.

NEW CLAIMS 37-39

New claims 37 and 38 should also be allowable for the reasons provided above, and notice thereof is earnestly solicited.

Additionally, new claim 38 recites at least about 0.1 weight percent of the first colorant and at least about 0.1 weight percent of the second colorant, wherein the first and second colorants are dyes. Katoh *et al.* generally teaches against a dye concentration in one of the media of greater than 0.1 weight percent. *See Katoh et al.* at column 13, lines 23-31.

It is respectfully submitted that an obviousness rejection based upon a reference that specifically teaches against the claimed invention is manifestly improper, and should not be made. For this additional reason, it is respectfully that the claim 38 should be allowable.

Finally, new claim 39 corresponds to previously pending claims 9 and 22, which were deemed to be allowable in substance by the examiner. Accordingly, the applicants respectfully submit that new claim 39 should also be allowed.

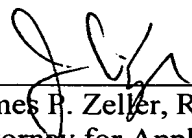
CONCLUSION

It is respectfully submitted that this application is now in condition for allowance. Should the Examiner wish to discuss the foregoing, or any matter of form or procedure in an effort to advance this application to allowance, she is respectfully invited to contact the undersigned attorney at the indicated telephone number.

Respectfully submitted,

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